

Application No.: 09/854,315
Amendment dated: September 23, 2003
Reply to Office Action of July 22, 2003

REMARKS

The specification has been amended at page 10 to correct an error in the description. Support for this amendment may be found in claims 1, 12 and 21.

Claims 12-28 have been withdrawn from consideration, the Applicants having elected claims 1-11 (Group I) with traverse. The withdrawn claims have not yet been canceled inasmuch as Applicants maintain that the restriction requirement is improper. In the Office Action, the Examiner indicated that the inventions of Groups I and II (claims 12-20) were distinct because the composition as claimed could be made by a materially different process such as being extruded into a free standing sheet. Likewise, the Examiner also stated that inventions of Groups I and III (claims 21-28) were distinct because the composition as claimed could be made by a materially different process such as being extruded into a free standing sheet. However, the specification indicates that the present invention relates to protective coating materials which are applicable to surfaces in liquid form. (Page 1, line 5-6.) Upon application to a surface, the masking composition is generally allowed to set or dry for about 5 to about 30 minutes. The Applicants maintain that such a composition is not amenable to extrusion into a free-standing sheet as the Examiner maintains. Withdrawal of the restriction requirement and examination of claims 12-28 on their merits is respectfully requested.

The Applicants have considered the Action and the cited art and believe the present invention, as amended, is patentably distinct from the cited art, either individually or in combination with any other art.

The Examiner rejected claim 2 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention. Claim 2 has been amended to recite that the plasticizer is a polyhydroxyalcohol, rather than reciting that the plasticizer is selected from the group consisting of polyhydroxyalcohols. Withdrawal of this rejection is respectfully requested.

The Examiner rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated

Application No. 09/854,315
Amendment dated September 23, 2003
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by Brown et al., U.S. Pat. No. 4,548,967, and under 35 U.S.C. § 103(a) as being obvious in view of Brown et al. The Examiner alleges that Brown discloses a masking agent comprising polyvinylpyrrolidone, water soluble plasticizer, surfactant and water and that it would have been obvious to follow the teachings of Brown to arrive at the present invention.

Anticipation requires the disclosure of each element of the claim at issue in a single reference. *W.L. Gore & Associates v. Garlock Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983) *cert. denied*, 469 U.S. 851 (1984). This requirement has not been met. The liquid masking composition of the present invention is distinguishable from the prior composition because Brown et al disclose a masking agent that contains at least 16 percent saccharide by weight. One of ordinary skill in the art would recognize that at such concentrations, the saccharide component is a significant film forming component of the composition. In contradistinction, the present invention contains less than 16 percent saccharide, which is insufficient to form a saccharide-based film. As stated on page 2 of the specification, polyvinylpyrrolidone (PVP) is considered to be unsuitable as a base for a masking film because it is known to be soluble in the organic solvents typically used in paints. The present invention provides a PVP-based masking composition that may be used as a masking composition, due to its resistance to hydrocarbons and chlorinated solvents. This hydrocarbon and chlorinated solvent resistance is provided by the plasticizer at the specified ratio of PVP to plasticizer. Brown et al provide no teaching or suggestion of a solvent resistant, PVP-based masking compound with less than 16 percent saccharide. Therefore, Brown et al do not teach or enable all of the elements of independent claim 1, or of dependent claims 2-11, which depend from, and include all the limitations of, claim 1.

To establish a *prima facie* case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference or combine the references cited. This motivation may be in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Examiner must also show that in modifying or combining references, there is a reasonable expectation of success, and that the references teach or suggest all of the claim limitations. (MPEP § 2143).

Application No.: 09/854,315
Amendment dated: September 23, 2003
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As stated above, saccharide is a significant film forming component of the masking agent disclosed and claimed by Brown et al. No teaching or suggestion is made regarding a masking composition containing less than 16 weight percent saccharide. Furthermore, all of the examples provided by Brown et al contain at least 41 percent corn syrup by weight. Therefore, Brown et al actually teach away from using less than 16 percent saccharide to form a masking agent. The Examiner has not established a suggestion or motivation to modify the teachings of Brown et al to arrive at the present invention. Likewise, the Examiner has not demonstrated that in modifying the teachings of Brown et al, one of ordinary skill in the art would have a reasonable expectation of success. Therefore, a *prima facie* case of obviousness of claim 1, in view of the teachings of Brown et al., has not been established. Withdrawal of the rejections of claim 1 under 35 U.S.C. § 102(b) and under 35 U.S.C. § 103(a) is respectfully requested.

Claims 4 and 5 also stand rejected as obvious over Brown et al. However, claims 4 and 5 provide additional limitations that are not taught or suggested by the prior art. For example, claim 4 recites, "said polyvinylpyrrolidone has a molecular weight distribution between about 200,000 and about 500,000." Brown et al specifically teach that the polyvinylpyrrolidone of their invention, "should have a molecular weight less than 50,000 grams/mole." (Column 2, lines 22-23.) Therefore, Brown et al teach away from the present invention as recited in claim 4. Claim 5 also patentably distinguishes over the prior art because it depends from, and includes all the limitations of, claim 4. Withdrawal of the rejection of claims 4 and 5 is respectfully requested.

Claims 2, 3 and 6-11 stand rejected under 35 U.S.C. § 103(a) as obvious over Brown et al and further in view of Blaine et al (U.S. Pat. No. 5,494,702) and Unefug et al. (U.S. Pat. No. 5,939,496). The Examiner maintains that it would have been obvious to add to Brown's masking agent:

- glycerine as a preferred plasticizer, as disclosed by Blaine et al, to prevent cracking of a finished coating and to enhance flow during application of the coating,

Application No. 09/854,315
Amendment dated. September 23, 2003
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- surfactants as disclosed by Blaine et al, to promote wetting and increase adhesion, and
- polyacrylate, as disclosed by Ungefug et al to increase viscosity for ease of storage and application.

As discussed above, the present invention parentably distinguishes over Brown et al. because Brown et al make no teaching or suggestion of a masking composition having less than 16 weight percent saccharide. Additionally, Blaine et al do not disclose the use of a polyvinylpyrrolidone-based masking compound but rather disclose a polyvinyl alcohol-based masking compound. The Examiner has not demonstrated a suggestion or motivation to combine the plasticizers of the polyvinyl alcohol-based masking compound of Blaine et al with the polyvinylpyrrolidone/saccharide-based masking agent of Brown et al to arrive at the present invention - a polyvinylpyrrolidone-based masking composition with less than 16 percent saccharides.

As mentioned above, the present invention provides a PVP-based masking composition that may be used as a masking composition, due to its resistance to hydrocarbons and chlorinated solvents. This hydrocarbon and chlorinated solvent resistance is provided by the plasticizer at the specified ratio of PVP to plasticizer. The Examiner has provided no teaching or suggestion that the plasticizers of Blaine et al will provide a solvent resistant, PVP-based masking compound. Likewise, the Examiner has not demonstrated that one of ordinary skill in the art would have had a reasonable expectation of success in adding plasticizer to PVP to make a composition having properties suitable for use as a masking agent. Instead the Examiner is impermissibly using hindsight to find the present invention obvious.

In the same way, the Examiner has also impermissibly used hindsight with regard to the polyacrylate thickening agents of Ungefug et al in combination with the compositions of Brown and Blaine to find the present invention obvious. Ungefug et al state that their polyacrylate thickeners are suitable for use in coatings commonly used in the textile field. No teaching or suggestion has been provided by the Examiner of the use of

Application No.: 09/854,315
Amendment dated: September 23, 2003
Reply to Office Action of July 22, 2003

these thickeners in a masking composition.

Therefore, the Applicants maintain that the Examiner has not established a *prima facie* case of obviousness of claims 2, 3 and 6-11 in view of the cited art, either individually or in combination. It is respectfully requested that the rejection of claims 2, 3 and 6-11 be withdrawn and that these claims be deemed allowable over the prior art.

Claim 29, which provides additional distinctions over the prior art, has been added. Claim 29 recites that the liquid masking composition of claim 1 is devoid of saccharides. Therefore, claim 29 also patentably distinguishes over the prior art, including the disclosure of Brown et al.

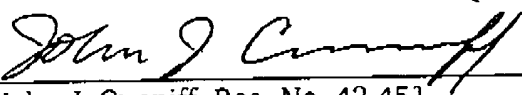
In light of the foregoing amendments and arguments presented herein, Applicants respectfully request reconsideration of the present application, withdrawal of the restriction requirement, and withdrawal of the rejections under 35 U.S.C. § 102(b), and 35 U.S.C. § 103(a) and 35 U.S.C. § 112. A formal Notice of Allowance of claims 1-29 is earnestly solicited. Should the Examiner care to discuss any of the foregoing in greater detail, the undersigned attorney would welcome a telephone call.

The Applicants have submitted this amendment with one additional claim. Accordingly, the undersigned attorney hereby authorizes the Commissioner to charge payment of any fees associated with this communication, including the fee of \$18.00 for one additional claim, or to credit any overpayment to deposit account number 18-0987.

Respectfully submitted,

Date: Oct 14, 2003

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